

REMARKS

It is believed that this Application has been amended in a manner that places it in condition for allowance at the time of the next Official Action.

Claims 1-15 are pending in the present application. Claim 2 has been cancelled. Claims 1 and 3-12 have been amended to more particularly point out and distinctly claim the present invention. New claims 13-15 have been added to vary the scope of the claimed invention. Support for new claims 13-15 may be found in original claims 1, 3 and 4.

Applicants note with appreciation the withdrawal of the restriction requirement. Applicants hence would also like to clarify that the grounds for traversing the restriction requirement in that restriction is proper only when the inventions are independent or distinct as claimed and there is a serious burden on the Examiner prior to the restriction requirement. In the present application, Applicants do not believe that the Official Action met its burden in showing that an examination of all the claims places a burden on the Examiner.

In the outstanding Official Action, the abstract of the disclosure was objected to because it allegedly used legal terminology. As an example, the Official Action stated that the term "comprising" was recited within the abstract. The abstract has been amended so that this term is no longer recited. Thus,

it is believed that the abstract complies with MPEP statute of 608.01(b).

In addition, the outstanding Official Action suggested guidelines for the preferred layout of the specification. Applicants thank the Examiner for the suggestion and have amended the specification to incorporate section headings were appropriate.

The outstanding Official Action also objected to the specification for informalities found at page 5, line 21 and page 1, lines 4-5. Applicants believe that the specification has been amended in a manner so that these informalities have been corrected.

Beginning on page 4 of the Official Action, the listing of references in the specification was alleged not to be a proper Information Disclosure Statement. In conjunction with this amendment, Applicants have also filed an Information Disclosure Statement pursuant to 37 C.F.R. 1.98(b).

Claims 1-12 were rejected under 35 U.S.C. 112, first paragraph, as allegedly being based on a non-enabling disclosure. This rejection is respectfully traversed.

Applicants believe that the present specification clearly provides one of ordinary skill in the art sufficient guidance to screen for test sequences with activity towards a receptor as set forth in the claimed invention.

Indeed, the Examiner's attention is directed to the present specification at page 4, line 6 to page 5, line 10, wherein it is described in detail how a library of test sequences can be provided. Moreover, at page 5, lines 11-26, the specification describes how to determine the activity of each test sequence of the library towards the receptor. The specification at page 5, line 27 to page 6, line 20 describes how a test sequence with a building block which exhibits activity at a certain position can be identified. Moreover, the examples demonstrate how to determine mimotope sequences for a variety of lead peptides, demonstrating the wide applicability of the method of the claimed invention.

Indeed, Applicants believe that the Official Action fails to meet its burden in showing that the present disclosure is non-enabling for the claimed invention. As the Examiner is aware, the PTO has the burden of giving reasons, supported by the record as a whole, as to why the specification as a whole is not enabling. In re WRIGHT, 999 F.2d 1557, 27 USPQd 1510 (CAFC 1993); Amgen Inc. vs. Chugai Pharm. Co. Ltd., 927 F.2d 1200, 17 USPQ2d 1016 (CAFC 1991); MOREHOUSE, 545 F.2d 162, 192 USPQ2d 9 (CCPA 1976); MARK, 12 USPQ2d 1904 (BPAI 1989).

Indeed, disclosures are enabling even if considerable amount of experimentation is involved, if it is merely routine. *Ex parte* FORMAL et al. 230 USPQ 546 (CAFC 1990); A.G. vs.

Advanced Machine, 28 USPQ 1270 (ILL. 1993). While the Official Action alleges that there are "numerous undefined variables" found in the claims that would require an undue amount of experimentation to practice the claimed invention. The Official Action fails to identify any of these allegedly undefined variables. Moreover, the Official Action does not provide any reasoning or evidence as to why the claimed invention is not enabled by the present disclosure in light of the record as a whole.

In view of the above, it is believed that the Official Action fails to satisfy it's burden in showing that claims 1 and 3-15 are not enabled by the present disclosure.

In the outstanding Official Action, claims 1-12 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully transversed.

The outstanding Official Action alleged that the terms "is favored at said position", "random library of test sequences composed of building blocks", "certain position", "next library of test sequences", and "selected building blocks" were a definite. However, Applicants respectfully submit that these terms would have been definite to one of ordinary skill in the art. For example, the specification defines the term a "molecule

that is composed of a number of building block" at page 3, lines 21-31. Moreover, the specification explains how a library can be provided/obtained at page 4, line 32 to page 5, line 36.

The Examiner's attention is also respectfully directed to SLOOTSTRA et al., Molecular Diversity, 1(1995b) 87-96, wherein the use of a library is described. The specification further explains these terms at page 5, line 34 to page 6, line 4. Thus, it is believed that these terms are definite to one of ordinary skill in the art.

The outstanding Official Action also alleged that the components of claim 1 did not have a characterizing or identifying feature that distinguished one from the other. The Official Action alleged that claim 1 was incomplete for omitting essential steps. In the interest of advancing prosecution, claim 1 has been amended to more particularly point out and distinctly claim the present invention by reciting additional steps and further clarifying the originally recited steps.

The outstanding Official Action also objected to the term "providing". However, Applicant's believe that the term is definite to one of ordinary skill the art. Applicant's believe that the term means to supply for use.

The outstanding Official Action also objected to the term "flat support medium". In the interest of advancing prosecution, this term is no longer recited in the claims.

In the outstanding Official Action the Examiner also raised several contentions regarding claim 2, claim 2 has been cancelled. Thus, it is believed that these contentions have been obviated by the present amendment.

As to claim 3, the outstanding Official Action alleged that the recitation of an amount of receptor "f" was inconsistent with the base claim. The Official Action also alleged that the term "smaller" was indefinite.

It appears that the Examiner's contention concerning step "f)" was well taken. Claim 3 has been corrected by deleting the term "f)" to reflect proper steps. However, Applicants respectfully submit that the term "smaller" is definite to one of ordinary skill in the art. Indeed, the term is further clarified in that it is relative to the amount set forth in each step. Thus, it is believed that claim 3 is definite to one of ordinary skill in the art.

Claims 4 and 5 were indefinite for reciting the term "factor". Claims 4 and 5 have been amended so that this term is no longer cited in the claims.

The outstanding Official Action alleged that claim 6 was unclear as to how many steps of step d) were recited in the claim. Moreover, the Official Action alleged that it was unclear which building blocks were replaced by a group of building blocks. In the interest of advancing prosecution, step i)

recites that steps e) - h) are repeated for a number of cycles efficient for finding a mimotope sequence with sufficient activity.

As further evidence that the claims are definite, the Examiner's attention is also directed to the present specification in page 7, lines 15-30 wherein the phrases "at least one building block" and "group of building blocks" are outlined.

As to claim 7, claim 7 was rejected because it was allegedly unclear as to which test sequences were being claimed. Amended claim 7 is believed to be definite as it refers to test sequences that have been provided in step a). Support for this recitation can be found in page 4, line 6-23 in the present specification. In the outstanding Official Action, claim 9 was objected to for containing the phrase "such as". Claim 9 has been amended so this phrase is no longer recited. Thus, it is believed that claim 9 is definite to one of ordinary skill in the art.

The use of the trademark BIACORE was also objected to. The specification and claims have been amended so this term is capitalized wherever it appears and is accompanied by the generic terminology.

Claim 11 was rejected for allegedly being indefinite. The Official Action alleges that the physical separation of the

test sequences was inconsistent with base claim 1. However, Applicant's respectfully submit that claim 11 only serves to show how the physical separation of test sequences can be performed. Indeed, it is believed that claim 11 is definite to one of ordinary skill in the art.

The Official Action rejected claim 12 for allegedly being indefinite for reciting the term "obtainable". However, claim 12 has been amended to recite that the mimotope has been obtained. As a result, it is believed that claim 12 is also definite to one of ordinary skill in the art.

Claims 1-12 were further rejected as indefinite for the reasons set forth by the Examiner in the international application at item VIII. This rejection is respectfully traversed.

As noted above, claims 1 and 3-12 have been amended to more particularly point out and distinctly claim the present invention. Moreover, Applicants believe that claims 13-15 have been drafted in a manner that is definite to one of ordinary skill in the art.

While Applicant's have taken into consideration the comments from the international examiner set forth in the search report of February 28, 2000, Applicants note that 35 U.S.C. §112, second paragraph, is the controlling provision used to determine whether the claims of an application are definite. With this in

mind, Applicant's believe that claims 1 and 3-15 satisfy the provisions of 35 U.S.C. §112, second paragraph.

In the outstanding Official Action, claims 1-12 were rejected under 35 U.S.C. §112(b) as allegedly being anticipated by any one of PINILLA et al., BLAKE, BLONDELLE et al., HALE, KOSTER et al. or application's disclosure of no prior art. This rejection is respectfully traversed.

In imposing the rejection, the outstanding Official Action states that the references are applied as best as the claims can be understood by the Examiner. The Official Action contends that each of the above-identified references fully meets the broad claimed invention, which is subject to numerous interpretations.

The interpretation taken by the Official Action is not provided. Moreover, Applicants believe that many of the terms cited by the Official Action were found in the specification. Upon reviewing these terms, it is believed that none of the cited publications anticipate or render obvious the claimed invention.

For example, the above-identified references do not disclose a method of the invention for determining a mimotope sequence, wherein each test sequence is located on a minicard. Thus, it is believed to be apparent that the above-identified publications fail to anticipate or render obvious the claimed invention.

Moreover, while it is true that Applicant stated that this application has been Examined by the International Examiner, Applicants note that the International Examiner did not examine the application based on the tenants of 35 U.S.C. §102(b) or 35 U.S.C. §103(a). Indeed, Applicants believe that if the International Examiner examined the present application in view of the controlling United States code, the International Examiner would have found that the present application was in condition for allowance.

Thus, Applicants believe that the cited publications fails to disclose or suggest the claimed invention.

In view of the present amendment and the foregoing remarks, therefore, it is believed that this application is now in condition for allowance, with claims 1 and 3-15 as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

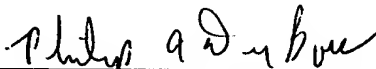
The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

Application No. 09/831,757
Amdt. dated December 18, 2003
Reply to Office Action of July 29, 2003
Docket No. 2004-1018

overpayment to Deposit Account No. 25-0120 for any additional
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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PD/psf

APPENDIX:

The Appendix includes the following item(s):

- an amended Abstract of the Disclosure